

Remarks

The present amendment is provided in response to the Office action dated May 31, 2007, in which claims 35 and 37-48 were rejected. In the present amendment, claims 35, 42, and 47 have been amended and claims 49-51 have been added. Accordingly, claims 35 and 37-51 are pending in the present application, with claims 35, 42, 47, and 48 being independent claims. Reconsideration and allowance of pending claims 35 and 37-48 and new claims 49-51 in view of the amendments and the following remarks are respectfully requested.

A. 35 U.S.C. §103(a)

Claims 35 and 37-48 stand rejected under section 103(a) as being anticipated by U.S. Patent No. 7,039,860 (“Gautestad”) in view of U.S. Patent No. 6,654,732 (“Mani”). The Office Action relies primarily on Gautestad as teaching the elements of the claims and states that the combination of Gautestad with Mani would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

A claim is unpatentable if the differences between it and the cited references would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on Applicant’s disclosure.

1. Suggestion or Motivation to Combine

The Office Action cites Gautestad as teaching all of the limitations of the cited claims, except a “list document including links to both a different document and the same document.” The Examiner cites Mani for the teaching of this element.

Gautestad is related to manually creating a web page category list before the list is served to a browser. (See, Gautestad, Column 1, Lines 8-15). Mani is concerned with a “search engine” querying a repository of XML documents. (See, Mani, Column 2, Lines 26-28). To make the query more efficient, the XML documents are viewed by the search engine as machine readable graphs, which allow, among other things, queries on the content and the structure of the document. (See, Mani, Column 2, Lines 29-30). The present claims include “information regarding how a plurality of links should be presented,” and “formatting each of the links in the list document for presentation on a user interface in accordance with the information regarding how the plurality of links should be presented.” (See, Paragraph 0008 of the present Application). The present claims also include “automatically” updating the list document when the links change.

There are very significant differences between the search engines of Gautestad and Mani and the building of a list document having links presented in accordance with information regarding their presentation to a user and automatically updating the list document, as is presently claimed. For example, a key concept in Gautestad is the notion of "categories" to which specific items (or pages) are assigned and then maintained as lists of items for each category. These categories are not automatically assigned in Gautestad. The teaching of Gautestad requires users to manually assign items to a category. For example, Gautestad cannot assign all homes for sale whose price is between \$100,000 and \$199,000. Instead, all teachings are to users assigning items to a category manually by clicking a radio button. (See, Gautestad, Column 9, Lines 52-67).

Gautestad teaches that a “search engine then returns an HTML-formatted screen image of a list of ‘hits’ to the user who has submitted a query.” (See, Gautestad, Column 2, Lines 18-25). As such, Gautestad does not update the “list document” automatically when the links change. Instead, if the links in Gautestad change, it would require a separate query from the user and the presentation of the results as a new “list document” to generate a change. For example, if the user made a search engine query for “dogs” a first set of results might be presented where the different web pages that matched dogs were found. If a new page on dogs was added, there would be no update until the user at some time in the future made another query for “dogs” and a completely new “list document” was generated.

Even though Gautestad may automatically place updates in a log file, the log file has to be transferred to a second computer on demand. The examiner has relied on the “list document” in Gautestad to be the result of a query. As such, even if Gautestad automatically updates a log file, it is not updating the list document because the list document is only changed once the log file is incorporated on the second computer and a new search is performed manually. Hence, the second results page on “dogs” is a new “list document” and the old list document has not been updated at all.

In Mani, the goal is to optimize query processing for a machine, such as a “search engine.” (See, Mani, Column 2, Lines 25-27). Hence, in Mani there is no motivation to format a “list document for presentation on a user interface in accordance with the information regarding how the plurality of links should be presented,” since machines do not read data in human readable form. As such, even if Mani were to be combined with Gautestad, it may motivate a person having ordinary skill in the art to optimize the queries of Gautestad, but by Gautestad’s nature it cannot automatically update a list document or provide links for user presentation to different pages and the same page. At best, the combination of Mani and Gautestad can optimize the generation of a results page of the search (which the Examiner has relied on as the list document). In no way, however, can Mani and Gautestad, alone or in combination automatically update the same list document or present links in accordance with information regarding user presentation of the links, as is presently claimed.

Because the Office Action has not cited any motivation taught by the references themselves to combine the diverse systems of Gautestad and Mani, Applicant respectfully submits that neither reference creates a suggestion or motivation to combine to achieve the current claims.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of Gautestad with the contrasting teachings of Mani points to the reasonable expectation of success in the present claims, which is the second requirement of the obviousness analysis. Gautestad teaches a search engine that mimics a database system, while Mani teaches an XML query optimization scheme.

If Mani were relied upon to supply the “inter-document” and “intra-document” links as cited in the Office Action, they would have to be in machine-readable form. To make the proposed

combination work, the machine-readable links would need to be transformed into links formatted for “presentation on a user interface” in the list document and/or transformed back to machine-readable form for the XML query so that they would be understandable to a machine such as a search engine. In that case the system is either inefficient, uses unnecessary steps, or would not work as needed to produce a list document suitable for a person to read.

If Gautestad were relied upon to automatically add updated links to the list document, it would require a second identical search and the generation of a new list document with new links. This method has unnecessary steps and it is not automatic, as it requires the user to enter a new search for the same term and the system must then repeat the same steps again. This also requires duplicative efforts by the machine, which wastes time, resources, and is not computationally efficient. As such, neither Gautestad nor Mani could reasonably be expected to succeed in achieving the present claims.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claims. Specifically, the claims require “information regarding how a plurality of links should be presented,” “formatting each of the links in the list document for presentation on a user interface in accordance with the information regarding how the plurality of links should be presented,” and “automatically” updating the list document when the links change.

The Office Action cites Gautestad as teaching a list document and Mani as teaching “intra-document” and “inter-document” links, but nowhere in either Gautestad or Mani is a teaching or suggestion that there can be information about how the links can be presented and then formatting the links to both the same and a different document for presentation on a user interface in accordance with the information. Additionally, neither of the cited references “automatically” update the list document when the links change.

For example, in Mani, the XML query optimization scheme uses links that are designed to be traversed by a search engine. By definition, these links cannot be understood by an ordinary person so they are not formatted for user presentation. In contrast, the present list document has links that

are designed to be displayed, read, formatted, and understood by a person. Furthermore, Gautestad is a searching scheme. Even if the results of the search is a “list document” as cited in the Office Action, the list document is static in nature. Even if Gautestad uses a log file that is updated automatically, it still must be transferred to a second computer on demand, which is not automatic. Moreover, any updates from the change log that are made on the second computer would only be reflected in a second “list document” that comes as a result of a second search. As such, Gautestad does not automatically update the same list document as is presently claimed. Accordingly, Gautestad and Mani fail to teach these aspects of the claims.

4. Effect of KSR

After the recent Supreme Court decision in the KSR case, although it is clear that the above analysis using the Federal Circuit’s teaching-suggestion-motivation test is not the only way to approach the obviousness inquiry, it remains a useful tool in the obviousness inquiry. However, even if an alternative tool is employed as part of the obviousness inquiry, it is clear from KSR that any combination of references in an obviousness rejection must provide reasonable inferences that are based on substantial evidence in the record. Here, no such substantial evidence has been identified and therefore even after KSR, Applicant asserts that the pending claims are not obvious in view of the cited references of record.

B. New Claims 49-51

Applicant has added new claims 49-51. New claim 49 includes the limitations of including at least a first human readable reference to a location that is external to the list document and a second human readable reference to a location that is internal to the list document. New claim 50 includes the limitations that the location that is external to the list document comprises a link to a uniform resource locator (URL) that is different from a URL for the list document. New claim 51 further defines that the location that is internal to the list document (inter document link) comprises a link to a URL that is the same as a URL for the list document but to a specific spatial location within the list document. This expands upon the human readable aspects of the claims and further distinguishes the cited references.

Applicant submits that the pending new claims are fully supported by the original disclosure of the application and do not add new matter. Applicant respectfully submits that the new claims 49-51 are presently in condition for allowance as each and every element of the pending claims are not disclosed by Gautestad or Mani. Based on the foregoing discussion, Applicant asserts that new claims 49-51 are presently allowable over Gautestad and Mani. Accordingly, a notice of allowance is respectfully requested.

C. Conclusion

If the Examiner has any questions or comments regarding the above Amendments and Remarks or believes that a telephone conversation may be useful in advancing prosecution, the Examiner is invited to contact the undersigned at the number listed below.

Respectfully submitted,
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